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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
NGUYEN BA, PAUL H	

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/929,742	TESCH ET AL.	
	Examiner	Art Unit	
	Paul Nguyen-Ba	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28,31-33 and 36-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28,31-33 and 36-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This action is responsive to Applicant's Arguments filed on 1/19/2006.

2. Claims 1-28, 31-33, 36-38 are currently pending. Claims 1, 7, 8, 9, 10, 11, 17, 18, 19, 20, 25, 26, 31, 36, 37, and 38 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-5, 7-15, 17-19, 25-28, and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oracle Forms ® Advanced Techniques ("Oracle"), Ch. 10, pgs. 1-18, © 1996 Oracle Corporation (*available at* http://mates.ms.mff.cuni.cz/oracle/doc/forms45/at/ch10.htm), in view of Lee et al. ("Lee"), U.S. Patent No. 6,061,696.

Regarding independent claim 1, Oracle teaches a method in a data processing system for processing a document containing an embedded object having a first format

corresponding to a first program (i.e., OLE) (see pgs. 2-3), the method comprising the steps of:

automatically determining whether the first program is an unavailable program (see pg. 17, heading: Converting OLE Objects – 1st paragraph. OLE object conversion is used for editing OLE objects when the OLE server application that originated an OLE object is **not available**);

when it is determined that the first program is an unavailable program, converting the embedded object into a second format different from the first format that is suitable for use with a second program that is available on the data processing system (see pg. 17 and 18, headings: Converting OLE Objects and Converting Embedded Objects. The "Convert To" command permanently alters the format of the object to the selected type for *automatic identification* of the selected type);

receiving an indication of a third format from a user (see pg. 18, step 3. The convert dialog shows the current object type and the conversion possibilities);

converting the embedded object into the third format (see pg. 18, step 4);

storing the embedded object in the third format (see pg. 18, step 5).

Oracle does not explicitly teach automatically converting the embedded object into a second format. However, Lee teaches *automatically converting the embedded object into a second format different from the first format that is suitable for use with a*

second program that is available on the data processing system (see Abstract; col. 5 lines 37-55 *et seq.* and Fig. 5).

Since Oracle and Lee are both from the same field of endeavor, the motivational purpose of freeing authors from the administrative burdens associated with maintaining different versions of an object and having to manually convert objects to web-publishable formats (see col. 3 lines 60-67) disclosed by Lee would have been recognized in the pertinent art of Oracle. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Oracle with the teachings of Lee.

Independent claims 7, 9, 10, 11, 17, 19, and 25 incorporate substantially similar subject matter as independent claim 1, and are rejected along the same rationale.

Regarding claims 2-5, 12, 14, 15, Oracle, in view of Lee, teaches:

receiving an indication of the second and third format from a user, determining and displaying the associated formats of the available programs to the user (see Oracle - pg. 18, step 3. The convert dialog shows the current object type and the conversion possibilities),

converting the embedded object into a third format and storing the embedded object (see Oracle - pg. 18, step 4 and step 5), and

automatically identifying a second format (see Oracle - pg. 17 and 18, headings: Converting OLE Objects and Converting Embedded Objects. The "Convert To" command permanently alters the format of the object to the selected type for *automatic identification* of the selected type).

Regarding independent claim 8, Oracle, in view of Lee, teaches a method in a data processing system containing a plurality of programs, each with an associated format, the data processing system for processing a document containing an embedded object having an originating format corresponding to an originating program (i.e. OLE) (see pgs. 2-3), the method comprising the steps of:

automatically determining whether the originating program is unavailable (see pg. 17, heading: Converting OLE Objects – 1st paragraph → OLE object conversion is used for editing OLE objects when the OLE server application that originated an OLE object is **not available**);

when it is determined that the originating program is unavailable, determining which of the plurality of programs are available on the data processing system (see pg. 18, step 3; see also pg. 17 and 18, headings: Converting OLE Objects and Converting Embedded Objects. The "Convert To" command permanently alters the format of the object to the selected type for *automatic identification* of the selected type.),

displaying the associated formats of the available programs to a user (see Figure on pg. 17), and

receiving an indication of a selected one of the displayed formats from the user (see pg. 18, step 3. The convert dialog shows the current object type and the conversion possibilities); and

converting the embedded object into the selected format (see pg. 18, step 4) *while the document is being loaded into memory* (see pgs. 17 and 18).

Oracle does not explicitly teach automatically converting the embedded object into a second format. However, Lee teaches *automatically converting the embedded object into a second format different from the first format that is suitable for use with a second program that is available on the data processing system* (see Abstract; col. 5 lines 37-55 *et seq.* and Fig. 5).

Since Oracle and Lee are both from the same field of endeavor, the motivational purpose of freeing authors from the administrative burdens associated with maintaining different versions of an object and having to manually convert objects to web-publishable formats (see col. 3 lines 60-67) disclosed by Lee would have been recognized in the pertinent art of Oracle. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Oracle with the teachings of Lee.

Regarding claim 13, Oracle, in view of Lee, teaches determining which of the plurality of programs are available on the data processing system (see Oracle - pg. 18,

step 3) and displaying the associated formats of the available programs to a user (see Figure on pg. 17).

Independent claims 18, 26, 31 incorporate substantially similar subject matter as independent claim 8, and are rejected along the same rationale.

Regarding claims 27, 32, Oracle, in view of Lee, teaches receiving the indication from a user and retrieving the indication from storage (see Oracle - pg. 18, step 4 and step 5).

Regarding claims 28 and 33, Oracle, in view of Lee, teaches *retrieving the indication from storage* (see Oracle - pg. 17 and 18, specifically step 5 → the "Convert To" command permanently alters the format of the object to the selected type for *automatic identification* of the selected type and is stored and recalled from storage).

5. Claims 6, 16, 20, 21, 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oracle Forms ® Advanced Techniques ("Oracle"), Ch. 10, pgs. 1-18, © 1996 Oracle Corporation (*available at* http://mates.ms.mff.cuni.cz/oracle/doc/forms45/at/ch10.htm), in view of Lee et al. ("Lee"), U.S. Patent No. 6,061,696, in further view of Francis et al. ("Francis"), U.S. Patent No. 6,182,092,

Regarding claims 6 and 16, Oracle, in view of Lee, teaches the method and computer readable medium of independent claims 1 and 11, but does not specifically teach converting the embedded object into an intermediate format.

However, Francis teaches converting OLE documents and objects into an intermediate format as a preprocessing step (see Fig. 6 and col. 14, lines 24-40) for the purpose instantiating the output, and hence, smoothing the transition between different formats.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Oracle, in view of Lee, with the teachings of Francis to include converting the embedded object into an intermediate format for the purpose instantiating the output, and hence, smoothing the transition between different formats.

Regarding independent claim 20, Oracle, in view of Lee, teaches a method and computer readable medium in a data processing system for processing a document containing an embedded object having a first format corresponding to a first program (i.e. OLE) (see pgs. 2-3), comprising the steps of:

determining whether the first program is an unavailable program (see pg. 17, heading: Converting OLE Objects – 1st paragraph);

when it is determined that the first program is an unavailable program, converting the embedded object into a second format different from the first format that is suitable for use with a second program that is available on the data processing system (see pg. 17 and 18, headings: Converting OLE Objects and Converting Embedded Objects), and

storing the format of the embedded object (see pg. 18, step 5).

Oracle, in view of Lee, does not specifically teach a first or second identifier wherein the second identifier can replace the first identifier. However, Francis teaches the use of identifiers to identify objects of a format embeddable in the document (see col. 2 lines 52-53 and col. 4 39-67 *et seq.*) for the purpose of associating and identifying different embedded objects in a document. Furthermore, it is well known to those of ordinary skill in the art that a first identifier can be replaced by a second identifier for the purpose of converting a first object format into a second object format.

Oracle does not explicitly teach automatically converting the embedded object into a second format. However, Lee teaches *automatically converting the embedded object into a second format different from the first format that is suitable for use with a second program that is available on the data processing system* (see Abstract; col. 5 lines 37-55 *et seq.* and Fig. 5).

Since Oracle and Lee are both from the same field of endeavor, the motivational purpose of freeing authors from the administrative burdens associated with maintaining different versions of an object and having to manually convert objects to web-

publishable formats (see col. 3 lines 60-67) disclosed by Lee would have been recognized in the pertinent art of Oracle. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Oracle with the teachings of Lee.

Regarding claim 21, Oracle, in view of Lee, does not specifically teach a first or second identifier wherein the second identifier can replace the first identifier. However, Francis teaches the use of identifiers to identify objects of a format embeddable in the document (see col. 2 lines 52-53 and col. 4 39-67 *et seq.*) for the purpose of associating and identifying different embedded objects in a document. Furthermore, it is well known to those of ordinary skill in the art that a first identifier can be replaced by a second identifier for the purpose of converting a first object format into a second object format.

Regarding claims 22-24, please refer to the rationale relied upon to reject independent claim 1 above.

6. Claims 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oracle Forms ® Advanced Techniques ("Oracle"), Ch. 10, pgs. 1-18, © 1996 Oracle Corporation (*available at* http://mates.ms.mff.cuni.cz/oracle/doc/forms45/at/ch10.htm), in view of Laverty et

al. ("Laverty"), U.S. Patent No. 6,396,593, in further view of Lee et al. ("Lee"), U.S. Patent No. 6,061,696.

Independent Claims 36-38

Oracle teaches the method, system, and computer-readable medium with respect to independent claim 1 as discussed above, but does not specifically teach selecting a user selectable setting comprising at least a first setting for performing the step of converting while the document is being loaded into memory and a second setting for performing the step of converting upon selection of the document for editing.

However, Laverty teaches user selectable conversion settings (see col. 6 lines 38-40) for the motivational purpose of allowing the human user to intervene, oversee, and drive all steps in the conversion process. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Oracle with the teachings of Laverty to include a choice of settings for performing the step of converting at various points of the conversion process for the motivational purpose of allowing the human user to intervene, oversee, and drive all steps in the conversion process.

Oracle does not explicitly teach automatically converting the embedded object into a second format. However, Lee teaches *automatically converting the embedded object into a second format different from the first format that is suitable for use with a*

second program that is available on the data processing system (see Abstract; col. 5 lines 37-55 *et seq.* and Fig. 5).

Since Oracle and Lee are both from the same field of endeavor, the motivational purpose of freeing authors from the administrative burdens associated with maintaining different versions of an object and having to manually convert objects to web-publishable formats disclosed by Lee (see col. 3 lines 60-67) would have been recognized in the pertinent art of Oracle. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Oracle with the teachings of Lee.

Response to Arguments

7. Applicant's arguments filed on 1/19/2006 have been fully considered but they are not persuasive.

Applicant contends that Oracle, in view of Lee, fails to disclose or suggest automatically converting an embedded object to a different format when it is determined that a first program is an unavailable program because Lee merely converts embedded objects between native and standard formats. Examiner respectfully disagrees.

As discussed in the above rejections, Oracle teaches "*converting an embedded object to a different format when it is determined that a first program is an unavailable*

program." (see pg. 17, heading: Converting OLE Objects – 1st paragraph. OLE object conversion is used for editing OLE objects when the OLE server application that originated an OLE object is **not available**). Examiner conceded only that Oracle does not explicitly teach automatically converting the embedded object into a second format (Emphasis added). However, this limitation was rendered obvious with the addition of the Lee reference. Lee teaches automatically converting the embedded object into a second format different from the first format that is suitable for use with a second program that is available on the data processing system (see Abstract; col. 5 lines 37-55 *et seq.* and Fig. 5).

Since Oracle and Lee are both from the same field of endeavor, the motivational purpose of freeing authors from the administrative burdens associated with maintaining different versions of an object and having to manually convert objects to web-publishable formats (see col. 3 lines 60-67) disclosed by Lee would have been recognized in the pertinent art of Oracle.

Applicant further contends that Lee does not determine whether a program is an unavailable program, and thus could not perform a conversion based on such a determination. Examiner respectfully disagrees. The Lee reference teaches a method to automatically convert an embedded objects into a format that is understandable to a web browser because most commercially HTML browsers only have programs that support a subset of all formats available (see col. 2 lines 33-42). The Lee reference, therefore, sets out to teach a method of automatically converting formats which are not

understandable to a web browser, due to the unavailability of a program within said browser that can read a particular first format, for the purpose of freeing authors from the administrative burdens associated with maintaining different versions of an object and having to manually convert objects to web-publishable formats that are understood by an available program in a web browser (see col. 3 lines 7-26 and col. 9 lines 21-65). Moreover, as discussed above, the Oracle reference expressly teaches *converting an embedded object to a different format when it is determined that a first program is an unavailable program.*

Regarding Applicant's contention that Francis fails to teach or suggest automatically converting an embedded object to a different format when it is determined that a first program is an unavailable program. Examiner respectfully notes that Oracle, in view of Lee, was used to teach this particular limitation, not Francis, which is only used to render the use of identifiers obvious.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-4094. The examiner can normally be reached on 11 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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4/10/06